REMARKS

[0003] Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-2, 4, 6-27 and 29-36 are presently pending. Claims amended herein are: 1, 4, 12, 19 and 31. Claims withdrawn or cancelled herein are: 3, 5 and 28.

Formal Request for an Interview

[0004] If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can talk about this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

[0005] Please contact me or my assistant to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for us, I welcome your call to either of us as well. Our contact information may be found on the last page of this response.

Claim Amendments and Additions

[0006] Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 1, 4, 12, 19, 31 herein.

Substantive Matters

Claim Rejections under § 102

[0007] Applicant submits that the anticipation rejections are not valid because, for each rejected claim, no single reference discloses each and every element of that rejected claim.[1] Furthermore, the elements disclosed in the single reference are not arranged in the manner recited by each rejected claim.[2]

Overview of the Application

[0008] The Application describes a technology for facilitating the transfer of a collection of digital items (e.g., a library of music files) from a source device to a target device. This technology helps to automate the decision process involved in selecting a meaningful subset of the library that will actually be transferred to the target device, and is particularly useful when the size of the to-be-transferred library is larger than the storage capacity of the target device.

[0009] The user ranks (i.e. assigns a priority to) the digital items in the library. Based on the assigned user-configurable priorities, the items in the library are sorted into multiple groups, so that the items in each group have like priorities. In addition, the priority of items in one group differs from the priority of items in the other groups. The sorted items with the highest priority are

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[1] "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); also see MPEP §2131.

[2] See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

designated for transfer and synchronization with the target device, such that the storage requirements of the designated items do not exceed the storage capacity of the target device.

Based upon Hurwitz

[0010]   The Examiner rejects claims 1-4, 6-27 and 29-36 under §102, as being anticipated by **Hurwitz:** *Hurwitz, et al.,* US Patent Publication No. 2005/0147130 (published July 7, 2005).

[0011]   Applicant respectfully traverses the rejections of these claims. Based on the reasons given below, Applicant asks the Examiner to withdraw the rejection of these claims.

[0012]   The Examiner cites Hurwitz as its primary reference in its anticipation-based rejections.   Hurwitz describes a system for priority-based execution of synchronization tasks of a synchronization session between a first and second device.   Specifically, the system receives a synchronization priority assignment for synchronization tasks and executes the synchronization tasks in order from a highest to a lowest synchronization priority.   The system may allow the synchronization process to be interrupted before all synchronization tasks have been completed.

Independent Claim 1

[0013]   Applicant submits that Hurwitz does not disclose, at least, the following (with emphasis added) from this amended claim:

> **determining a *storage capacity*** of a target device coupled to a source device;
>
> sorting a collection of digital items stored on the source device and **dividing the collection into multiple tiers of digital items**, wherein **each tier is a subset of the collection and the items in each tier have *like priorities*** and the priority of items in one tier differs from the priority of items in the other tiers, the sorting being based, at least in part, upon a user-configurable priority assigned to the digital items in the collection;
>
> **designating at least one of the tiers of sorted digital items** with highest priority **for synchronization** with the target device, wherein the *storage requirements of the designated tier* of digital items are less **than or equal to the storage capacity** of the target device;

[0014]   Hurwitz does not disclose **determining a storage capacity** of a target device, and **designating** the sorted digital items for synchronization, such that the **storage requirements of the designated digital items are less than or equal to the storage capacity of the target device**.   Rather, Hurwitz is merely concerned with the problem of encountering interruptions in the synchronization process, and uses priority assignments to manage the order of execution of synchronization tasks so as to increase the likelihood that the higher priority synchronization tasks are completed before interruptions are encountered.

[0015]   Further, Hurwitz does not disclose the use of multiple priority groupings of digital items. Rather, Hurwitz only **sorts** and ***does not divide*** its synchronization tasks into **multiple tiers of digital items**, wherein each tier is

a subset of the collection and the items in each tier have **like priorities**, as claimed. In fact, the synchronization tasks in Hurwitz are assigned *different priorities*. See, for example, Hurwitz Fig. 3.

[0016] Consequently, Hurwitz does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Dependent Claims 2, 4, 6-11

[0017] These claims ultimately depend upon independent claim 1. As discussed above, claim 1 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

Independent Claim 12

[0018] Applicant respectfully submits that Hurwitz does not disclose, at least, the following from this claim (with emphasis added):

> a first display area illustrating a listing of one or more digital items from a collection of digital items stored on a source device, **the collection being divided into multiple tiers**, wherein **each tier is a subset of the collection** and the **items in each tier have** *like priorities* for synchronization with a target device coupled to the source device and one of the tiers having the highest priority amongst the multiple tiers; ...

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an executable process associated with the one or more digital items in the listing that is configured to:

> determine a *storage capacity* of the target device;
> designate the tier with highest priority, wherein the **storage requirements of the *designated tier* of digital items are less than or equal to the storage capacity of the target device;**
> synchronize the designated tier of digital items with the coupled target device.

[0019] Hurwitz nowhere discloses the entire collection is divided into multiple tiers, where each tier is a subset of the collection and items in each tier having like priorities, as claimed. Rather, Hurwitz only sorts and does not divide its synchronization tasks into multiple tiers.

[0020] Moreover, Hurwitz uses priority assignments to order the execution of synchronization tasks so as to increase the likelihood that the higher priority synchronization tasks are completed before interruptions are encountered during the synchronization process. Nowhere does Hurwitz disclose **determining a storage capacity** of a target device, and designating the tier with highest priority, wherein the storage requirements of the **designated tier** of digital items are **less than or equal to the storage capacity** of the target device.

[0021] Consequently, Hurwitz does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Dependent Claims 13-18

[0022] These claims ultimately depend upon independent claim 12. As discussed above, claim 12 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

Independent Claim 19

[0023] Applicant submits that Hurwitz does not disclose, at least, the following (with emphasis added) from this claim:

> **determining a *storage capacity*** of a target device; ...
> **dividing the sorted collection into multiple groups** of digital items, wherein the **items in each group have *like priorities*** and the priority of items in one group differs from the priority of items in the other groups, the sorting being based, at least in part, upon a user-configurable priority assigned to the digital items in the collection;
> **designating at least one of the groups** of sorted digital items with highest priority for synchronization with the target device, wherein the ***storage requirements of the designated group*** of digital items are less **than or equal to the storage capacity** of the target device;

[0024] Since Hurwitz nowhere discloses determining a storage capacity of a target device, dividing items into multiple groups with items in each group have like priorities, and designating at least one of the groups for synchronization, wherein the storage requirements of the designated group are less than or equal to the target device's storage capacity, this claim differs from it.

[0025]   Consequently, Hurwitz does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Dependent Claims 20-26

[0026]   These claims ultimately depend upon independent claim 19. As discussed above, claim 19 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

Independent Claim 27

[0027]   Applicant submits that Hurwitz does not disclose, at least, the following (with emphasis added) from this claim:

> a first display area illustrating a listing of one or more digital items from a collection of digital items stored on a source device, **the collection being *divided into multiple tiers*, wherein each tier is a subset of the collection and the items in each tier have *like priorities*** for synchronization with a target device coupled to the source device and one of the tiers having the highest priority amongst the multiple tiers;

[0028]   Hurwitz nowhere discloses the use of multiple priority groupings of digital items. Rather, Hurwitz only **sorts** and ***does not divide*** its **synchronization tasks into multiple tiers**, wherein each tier is a subset of the collection and the items in each tier have **like priorities**, as claimed.

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Hurwitz assigns different priorities to the synchronization tasks. See, for example, Hurwitz Figure 3.

[0029]   Consequently, Hurwitz does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Dependent Claims 29-30

[0030]   These claims ultimately depend upon independent claim 27. As discussed above, claim 27 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

Independent Claim 31

[0031]   Applicant submits that Hurwitz does not disclose, at least, the following (with emphasis added) from this claim:

> a **storage capacity determining means** for determining a **storage capacity of a target device** coupled to a source device;
> a **sorting-and-dividing means** for sorting a collection of digital items stored on the source device and **dividing the collection into multiple groups of digital items, wherein the items in each group have *like priorities*** and the priority of items in one group differs from the priority of items in the other groups, the sorting being based, at least in part, upon a user-configurable priority assigned to the digital items in the collection;

a **designating means** for designating at least one of the groups of sorted digital items with highest priority for synchronization with the target device, **wherein the storage requirements of the designated group of digital items are less than or equal to the storage capacity of the target device**; ...

[0032]   Nowhere does Hurwitz disclose "a storage capacity determining means for a storage capacity of a target device ..." or a "designating means", as claimed.   Rather, since Hurwitz is merely concerned with the problem of encountering interruptions in the synchronization process, it uses priority assignments to order the execution of synchronization tasks to increase the likelihood that the higher priority synchronization tasks are completed before interruptions are encountered.

[0033]   Further, Hurwitz does not disclose "a **sorting-and-dividing means for ... dividing the collection into multiple groups,**" as claimed.   Since Hurwitz only **sorts** and *does not divide* its synchronization tasks, this claim differs from it.

[0034]   Consequently, Hurwitz does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Dependent Claims 32-36

[0035]   These claims ultimately depend upon independent claim 31.   As discussed above, claim 31 is allowable.   It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable.   Additionally,
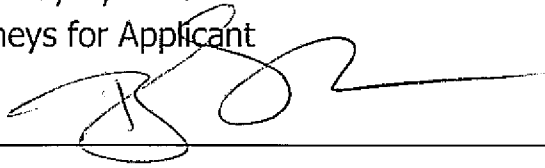
some or all of these claims may also be allowable for additional independent reasons.

Conclusion

[0036]   All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application.   If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action**.   Please call/email me or my assistant at your convenience.

Respectfully Submitted,

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Dated: 5-30-08

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